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EXAMINER

STOCKTON, LAURA LYNNE

| ART UNIT | PAPER NUMBER |
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| 1626 | |

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

MERGED REISSUE and REEXAM APPLICATIONS

Application Number: 09/810,650

Filing Date: March 15, 2001

Appellant(s): URANO ET AL.

Application Number: 90/004,812

Filing Date: October 23, 1997

Appellant(s): URANO ET AL.

James E. Armstrong, IV
For Appellant

EXAMINER'S ANSWER

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This is in response to the appeal brief filed
April 27, 2006 appealing from the Office action mailed
November 1, 2005.

(1) Real Party in Interest

A statement identifying by name the real party in interest
is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any other pending related
appeals, interferences, or judicial proceedings which will
directly affect or be directly affected by or have a bearing on
the Board's decision in the pending appeal. The Board is,
however, reminded of the previous Board decision on
September 24, 1999 and affirmed by the CAFC on February 1, 2001
in the Reexam application.

(3) Status of Claims

The statement of the status of claims contained in the
brief is correct.

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(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is incorrect only because the Appellant did not know if the after-final amendment that was filed with the Brief would be entered or not.

The amendment after final rejection filed on June 1, 2006 has been entered.

The amendment after final rejection filed on April 27, 2006 has not been entered.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct. The changes are as follows.

The outstanding issue of whether a nonprecedential opinion can be used as precedent and cited against the Appellant by the

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Examiner, in violation of Fed. Cir. R. § 47.6(b) is a new issue raised by the Appellant in the Brief.

WITHDRAWN REJECTIONS

The following grounds of rejection are not presented for review on appeal because they have been withdrawn by the examiner. The rejection of claims 8 and 9 under 35 U.S.C. 112, first paragraph for lack of written description.

Appellant's brief presents arguments relating to the issue of claims 10 and 11 being duplicates of claims 8 and 9, which is an objection. This issue relates to petitionable subject matter under 37 CFR 1.181 and not to appealable subject matter. See MPEP § 1002, § 1201 and § 1.113.

(7) Claims Appendix

The copy of the appealed claims contained in the brief and in the Supplemental Claim Appendix to the brief filed June 1, 2006 is correct.

(8) Evidence Relied Upon

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(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejection - 35 U.S.C. 102

Claims 8-11 are rejected under 35 U.S.C. 102(e) as being anticipated by Pawlowski et al. {U.S. Pat. 5,338,641}.

Pawlowski et al. disclose compounds which are embraced by the instant claimed invention and therefore, anticipate the instant claimed invention. See the following table.

| Appellant's Compounds | Pawlowski et al.'s Compounds | Instant Claims Anticipated |
|---|---|-------------------------------|
| $\begin{array}{c} R^1SO_2CSO_2R^2 \\ \\ N_2 \end{array}$ | $\begin{array}{c} R-SO_2-C-SO_2-R \\ \\ N_2 \end{array}$ | |
| R^1 and R^2 are each cyclohexyl | Bis(cyclohexylsulfonyl)diazomethane (column 4, line 46) Each R variable represents a cyclohexyl | Claims 8 and 10 |
| R^1 and R^2 are each branched butyl (e.g., iso-butyl) | Bis (2-methyl-propyl-sulfonyl)-diazomethane (column 4, line 33) Each R variable represents a branched alkyl (e.g., 2-methyl-propyl) | Claims 9 and 11 |
| R^1 and R^2 are each branched butyl (e.g., sec-butyl) | Bis(1-methyl-propyl-sulfonyl)-diazomethane (column 4, line 32) Each R variable represents a branched alkyl (e.g., 1-methyl-propyl) | Claims 9 and 11 |

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Claim Rejection - 35 U.S.C. 103

Claims 9 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pawlowski et al. {U.S. Pat. 5,338,641}.

Determination of the scope and content of the prior art (MPEP §2141.01)

Appellant claims diazodisulfones. Pawlowski et al. teach diazodisulfones {e.g., α,α -bis(sulfonyl)-diazomethanes} which are either structurally the same as (see above 102 rejection) or structurally similar to the instant claimed compounds. See in Pawlowski et al., for example, formula I in column 3 (lines 38-49) wherein R represents butyl (including positional isomers - e.g., tert-butyl) or cyclohexyl {column 3, lines 8-15, 40-49, 66-68; column 4, lines 1-2; and especially the compounds in column 4, lines 32-34}.

Ascertainment of the difference between the prior art and the claims (MPEP §2141.02)

The difference between some of the compounds of the prior art and the compounds instantly claimed is that the instant claimed compounds are generically described in Pawlowski et al.

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Finding of prima facie obviousness--rational and motivation (MPEP §2142-2413)

The indiscriminate selection of "some" among "many" is *prima facie* obvious. The motivation to make the claimed compounds derives from the expectation that structurally similar compounds would possess similar activity (e.g., forms a strong acid on exposure to actinic radiation).

One skilled in the art would thus be motivated to prepare compounds embraced by the reference genus to arrive at the instant claimed compounds with the expectation of obtaining additional beneficial compounds which would be useful in forming a strong acid on exposure to actinic radiation. The instant claimed invention would have been suggested to one skilled in the art and therefore, the instant claimed invention would have been obvious to one skilled in the art.

(10) Response to Argument

Appellant argues that relief is sought in this second appeal from the improper rejection of two individual compound claims and from the improper use of the previous nonprecedential Federal Circuit decision is in violation of Fed. Cir. R. §47.6(b), APA § 706 and *Burke Inc. v. Bruno Indep. Living Aids, Inc.*, 51 USPQ2d 1295 (Fed. Cir. 1999). Appellant argues that,

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unlike in the exception explained in *Burke*, the Examiner applied *In re Wako Pure Chemical Industries Ltd.* (Nonprecedential Opinion 00-1139, February 1, 2001), to deny the Appellant a fair examination of newly appealed claims 8-11 and instead, treated the examination after *In re Wako* as a repeat of the examination before, in spite of the fact that the previous claims were directed to subgenera of the alkyls with 3 to 8 carbon atoms, rather than the present claims of singular scope involving individual compounds. Appellant further argues that since the previously appealed claims and the present claims on their face are completely different in scope, the rejection of the final Office Action relying on the rationale of *In re Wako* should be expunged from the record because they are contrary to law, confusing and highly prejudicial to the Appellant.

Appellant's arguments have been considered. Firstly, the issue of whether a nonprecedential opinion can be used as precedent and cited against the Appellant by the Examiner, in violation of Fed. Cir. R. § 47.6(b) is a new issue raised by the Appellant in the Brief. Secondly, *In re Wako Pure Chemical Industries Ltd.* (Nonprecedential Opinion 00-1139, February 1, 2001) is the Judgment found in the Reexam application (90/004812) which has been merged with the instant

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Reissue application. Thirdly, the instant claims were not rejected based on the decision in *In re Wako*. Appellant's Japanese priority document was reviewed as it relates to the instant claimed invention in this reissue application. It was determined that Appellant's Japanese priority document lacks sufficient adequate written description for the specie found in instant claims 8 and 10 and the very small subgenus found in instant claims 9 and 11. Therefore, Appellant was not afforded the benefit of the filing date of their Japanese priority document and the claims are properly rejected over Pawlowski et al.

The same issues in the instant Reissue application (i.e., rejection of the claims under 35 USC § 102(e) and 35 USC § 103) were addressed in the decision by the Board of Patent Appeals and Interferences dated September 24, 1999 and the United States Court of Appeals for the Federal Circuit dated February 1, 2001 (i.e., *In re Wako*) in the Reexam application. It was determined that Appellant's Japanese priority document did not have sufficient support for the instant claimed invention and therefore, Appellant was not afforded the benefit of the filing date of their Japanese priority document. The claims on appeal in the Reexam were a genus found in claim 1, sub-genera found in

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claims 2, and 4-6, and a list of 10 specie found in claim 3. The Examiner was affirmed by the Board of Appeals on appealed claims 1-6 on the rejection of the claims under 35 USC § 102(e) and 35 USC § 103. The Examiner was affirmed by the Federal Circuit on appealed claims 1 and 4-6 on the rejection of the claims under 35 USC § 102(e) and 35 USC § 103. Claims 2 and 3 were not appealed by Appellant to the Federal Circuit.

It is agreed that instant claims 8 and 10 are directed to an individual species and are of a different scope than the claims in the Reexam. It is not agreed that claims 9 and 11 are directed to an individual species, although of different scope than the claims in the Reexam, since a "branched butyl" embraces the isomers *iso*-butyl, *sec*-butyl and *tert*-butyl and therefore, claims 9 and 11 cannot be considered claims directed to an individual species.

It is noted that Appellant failed to mention claim 3 of the Reexam application, which lists ten (10) specie. Although the Federal Circuit could not decide on claim 3, because Appellant chose not to appeal claim 3, the Board of Patent Appeals and Interferences affirmed the rejection of claim 3. Also note that the first species in claim 3, which was specifically discussed in the Examiner's Answer of the Reexam on

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page 10, is the same species in instant claims 8 and 10. The fourth and fifth specie in claim 3 are embraced by instant claims 9 and 11.

Appellant argues that the disclosure of the priority document simply lists several possible compounds in shorthand form and the ability to read and understand a list of familiar nomenclature in the 100 plus year old alkane art is straightforward. Appellant argues that the Examiner admits that the language is found in the priority document for claims 8 and 9 in the Office Action of November 1, 2005 on page 11, lines 10-11.

Appellant's arguments have been considered. The term "alkane" is understood. The Examiner did admit that the language in claims 8 and 9 was found in the priority document, the language being "cyclic alkyl group" (page 14, line 7 of Appellant's English translation of their Japanese priority document submitted in the Reexam on August 3, 1998), "branched" (page 14, line 7), "hexyl" (page 14, line 10) and "butyl" (page 14, line 10). This language, "cyclic alkyl group", "branched", "hexyl" and "butyl", is found under the definition of "alkyl" in the Japanese priority document. However, the question that arises is does the definition of "alkyl", along with the

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definitions of other possible substituents that R^1_0 and R^2_0 could represent, give adequate written description or support for any sub-genera (as found in instant claims 9 and 11) or species (as found in instant claims 8 and 10) without any further guidance or direction from the Japanese priority document. It is has been determined that Appellant's Japanese priority document does not provide adequate written description or support for the species of instant claims 8 and 10 nor the sub-genus of claims 9 and 11.

Appellant argues that the Examiner confuses *res judicata* on a separate subgenus issue to prejudice the Appellant in a completely new set of reissued claims of singular scope since the Examiner has noted the first compound in claim 3 which was rejected by the Board in a previous appeal and not appealed to the Federal Circuit. In response, the Examiner has not been confused on this point. Each of claims 8-11 of this reissue application was examined on their own merits. Upon review of Appellant's Japanese priority document, it was determined that the instant claimed invention was not supported in the Japanese priority document.

Further, it is agreed that claim 3 in the Reexam listed 10 specie. However, the specific compounds of Pawlowski et al.

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identified in the 35 U.S.C. 102(e) rejection of claims 1-6 in the Reexam were those found in column 4, lines 32, 33 and 46 (see page 4 in the Examiner's Answer of the Reexam). As seen in the Table (reproduced below) found under the 35 U.S.C. 102(e) rejection of instant claims 8-11, the same compounds of Pawlowski et al. are identified, see the middle column of the Table.

| Appellant's Compounds | Pawlowski et al.'s Compounds | Instant Claims Anticipated |
|---|---|----------------------------|
| $\begin{array}{c} \text{R}^1\text{SO}_2\text{CSO}_2\text{R}^2 \\ \parallel \\ \text{N}_2 \end{array}$ | $\begin{array}{c} \text{R}-\text{SO}_2-\text{C}-\text{SO}_2-\text{R} \\ \parallel \\ \text{N}_2 \end{array}$ | |
| R^1 and R^2 are each cyclohexyl | Bis(cyclohexylsulfonyl)diazomethane (column 4, line 46) Each R variable represents a cyclohexyl | Claims 8 and 10 |
| R^1 and R^2 are each branched butyl (e.g., iso-butyl) | Bis (2-methyl-propyl-sulfonyl)-diazomethane (column 4, line 33) Each R variable represents a branched alkyl (e.g., 2-methyl-propyl) | Claims 9 and 11 |
| R^1 and R^2 are each branched butyl (e.g., sec-butyl) | Bis(1-methyl-propyl-sulfonyl)-diazomethane (column 4, line 32) Each R variable represents a branched alkyl (e.g., 1-methyl-propyl) | Claims 9 and 11 |

These three individual compounds of Pawlowski et al. were the Examiner's focal point in the prosecution of the Reexam since

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the first Office Action in the Reexam dated June 3, 1998 {see especially the 35 U.S.C. 102(e) rejection on page 2}. All three of these compounds of Pawlowski et al. were disclosed in the specification of the Reexam and were being claimed. If the Examiner had determined in the prosecution of the Reexam that any one of these three compounds had sufficient written description in Appellant's Japanese priority document, the Examiner would not have specifically identified each and every one of these three species in the 35 U.S.C. 102(e) rejection as the basis for the rejection. For Appellant to assert that the Examiner has prejudiced the Appellant by not considering the differences in the scopes of claims 1-6 in the Reexam and claims 8-11 in the instant reissue application is completely unfounded.

However, the record is clear that the Examiner, not the Board of Appeals and not the Federal Circuit, had determined by June 3, 1998 (the date of the first Office Action in the Reexam) that the compounds:

Bis(cyclohexylsulfonyl)diazomethane,

Bis(2-methyl-propyl-sulfonyl)diazomethane and

Bis(1-methyl-propyl-sulfonyl)diazomethane,

which are all found in the disclosure of Pawlowski et al. and in the specification and claims of the Reexam, did not have

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adequate written description in Appellant's Japanese priority document. Therefore, Appellant was not afforded the date of their Japanese priority document and the patent to Pawlowski et al. would anticipate and would make obvious any claim by the Appellant, regardless of scope, which listed any one or all of these compounds or claims which embrace one or more of these three compounds. Appellant in the instant reissue application has specifically claimed the species Bis(cyclohexylsulfonyl)-diazomethane in instant claims 8 and 10 and has generically claimed the specie Bis(2-methyl-propyl-sulfonyl)diazomethane and Bis(1-methyl-propyl-sulfonyl)diazomethane in instant claims 9 and 11. As a result, claims 8-11 have been rejected under 35 U.S.C. § 102(e) and claims 9 and 11 have also been rejected under 35 U.S.C. § 103.

Appellant continues to argue that support for the claimed compounds of claims 8-11 is found in their Japanese priority document {JP 2-019614} filed January 30, 1990, which predates Pawlowski et al. that was filed September 7, 1990. Therefore, Appellant argues that claims 8-11 are not anticipated by Pawlowski et al. nor are claims 9 and 11 obvious over Pawlowski et al.

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Appellant's argument has been considered but has not been found persuasive. In Appellant's Japanese priority document {JP 2-019614} filed January 30, 1990, the R_o^1 and R_o^2 {or R^1 and R^2 } variables are defined, each independently from the other, as "a straightly linear, branched or cyclic alkyl group having 1 to 10 carbon atoms". There are also a number of other substituents that are represented by the R_o^1 and R_o^2 variables. None of the specific compounds disclosed and claimed in the instant application were disclosed in Appellant's Japanese priority document.

The rejection of the claims over Pawlowski et al. under 35 U.S.C. § 102(e) is proper because Appellant had not disclosed in their Japanese priority document the very small sub-genus found in instant claims 9 and 11 nor the species disclosed and claimed in instant claims 8 and 10 in the instant application. Therefore, Appellant is not entitled to the date of their Japanese priority document filed January 30, 1990 for the very small sub-genus of instant claims 9 and 11 or species of instant claims 8 and 10. Appellant can only rely on the filing date of application no. 07/646,909 {January 28, 1991} for support for these compounds. However, Pawlowski et al. can rely on the filing date of Application No. 07/578,465 {September 7, 1990}

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for support of the same species as found in instant claims 8 and 10 and the very small genus found in claims 9 and 11.

Therefore, the rejection of instant claims 8-11 under 35 U.S.C. § 102(e) over Pawlowski et al. and the rejection of instant claims 9 and 11 under 35 U.S.C. § 103 also over Pawlowski et al. are both deemed proper and should be maintained.

Appellant's arguments directed to the objection of claims 9 and 11 as being duplicates of claims 8 and 10, respectively, will not be addressed because, as stated above, objections are not appealable.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board, other than the previous decision by the Board on September 24, 1999 and affirmed by the CAFC on February 1, 2001 in the Reexam application, is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

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For the above reasons, it is believed that the rejections
should be sustained.

Respectfully submitted,

LLS



July 20, 2006

Conferees:

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